



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

45384

In the Application of:
KORBER et al.

Filing Date: June 30, 2003

Serial No. 10/608,416

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Art Unit: 1614

Examiner: N. Zhang

For: COMPACTED LACTIC ACID MENTHYL ESTER

**RESPONSE TO RESTRICTION REQUIREMENT
AND ELECTION OF SPECIES**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

September 28, 2006

Dear Sir:

Response to Restriction Requirement

In response to the Restriction Requirement and Election of Species requirements in the Action dated July 28, 2006 Applicants to prosecute the invention of Group I, claims 1-6.

This election is without traverse as to Groups I and III, but is with traverse as to Groups I and II. Claims 4-6 are product by process claims. Claims 7-11 are dependent claims that specifically refer to the manufacture of a compact according to claims among those elected. A search of the Group I claims will necessarily involve the search of the Group II claims.

In addition, the stated rationale for differentiation is based on the unsupported assertion that the formation of an 80% compact is a materially different process than the manufacture of a compact with 90% lactic acid methyl ester. This assertion is unsupported by the claim language calling for "at least 80%" in claims 1 and 7.

Election of Species

The examiner further requires an election of species for product compositions containing either (A) 1-lactic acid 1-menthyl ester or (B) some other lactic acid menthyl ester. Once a compound is elected, a further formulation election is required among three levels of concentration (80-90 wt%, 90-95 wt%, and ≥ 95 wt%).

The reasons presented by the examiner do not identify any degree of burden or additional search as a result of the claims scope. Instead, the rationale is that lactic acid menthyl ester has a number of structurally different compounds and the concentration level affects storage stability.

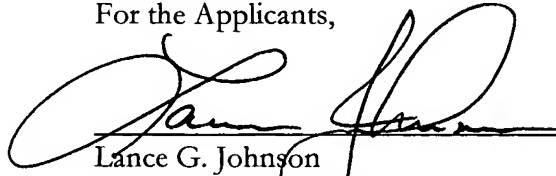
Applicants will elect to prosecute the 1-lactic 1-menthyl ester compound in a concentration of at least 95 wt%. Claims 1-6 are encompassed by this election.

This election is with traverse because the Election of Species Requirement does not comply with the dictates of the MPEP § 806.04 and sub-sections thereof. This Section requires that any election of species requirement may be made only where it is determined that the species are independent or patentably distinct from each other. Such a determination has not been made in the present instance and should not be maintained.

Moreover, the identified species are linked by a generic claim calling for "lactic acid menthyl ester compacts" of any sort having a concentration of "at least 80% (m/m)."

There is no basis for the present election of species requirements. Reconsideration is respectfully requested.

For the Applicants,



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